

## **REMARKS/ARGUMENTS**

Applicant would like to thank the Examiner for the careful consideration given the present application. Reconsideration of the subject patent application in view of the present remarks is respectfully requested.

Claims 4, 7, 9, 12-13, 15 and 17-29 are cancelled.

Claims 1-3, 5-6, 8, 10-11, 14 and 16 are amended.

New claims 30-38 are added.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a), because the drawings must show every feature of the invention specified in the claims. The claims of which the features are not shown in the drawings have been cancelled. Thus, the objection as it applies to the drawings should be withdrawn.

### ***Specification***

The abstract of the disclosure is objected to because the abstract is a repeat of the first independent claim of the disclosure. The abstract has been amended to include the proper content. Thus, the objection as it applies to the abstract should be withdrawn.

### ***Claim Rejections - 35 USC § 102***

Claims 1-3, 5-8, 10-11, 14, 16-17, and 19-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Maaskamp et al. (US 6013046; hereinafter “Maaskamp”). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Claims 7, 17 and 19-26 have been cancelled. Thus, the rejection as it applies to claims 7, 17 and 19-26 should be withdrawn.

Regarding the amended claim 1, Maaskamp does not disclose that the rod member is solid throughout. There is no disclosure in Maaskamp that the needle 12 which corresponds to the rod member of the present invention is solid throughout. Since the limitations of claim 18 are incorporated into the amended claim 1, the following will discuss the reference, Murry et al (US 3990452) which is cited against claim 18. The Office action states that Murry discloses a solid tapered rod member for use with ultrasonic surgical devices (Figure 7a). However, there is no disclosure in Murry that the solid tapered rod member is solid throughout. Instead, the rod member shown in Figure 7c of Murry is hollow at the distal end. Also, Murry is not combinable with Maaskamp to create the present invention. Although a rigid “teaching, suggestion, or motivation” test (TSM test) is not an appropriate test for obviousness inquiry, it is still required to show a reason for combining the elements in the manner claimed (KSR International, Co. v. Teleflex Inc., 550 U.S. 398). Here, Murry merely discloses a machine for performing surgery and treatment utilizing ultrasonic energy. There is no reason to use the rod member disclosed in Murry for a phacoemulsification needle arranged for use in bimanual phacoemulsification procedures. Accordingly, there is no reason for combining Murry with Maaskamp for obviousness inquiry.

Also, Maaskamp does not disclose that the hollow tube member disposed about the solid rod member is arranged for transmission of ultrasonic energy to an ocular substrate to effect emulsification thereof.

Moreover, Maaskamp does not disclose that a phacoemulsification needle is arranged for use in bimanual phacoemulsification procedures. With the bimanual phacoemulsification procedures, a separate device is used to provide irrigation fluid to the eye during phacoemulsification procedure. This bimanual procedure has the advantage of enabling very small incisions to be made in the eye to enable the procedure to be carried out.

Therefore, since every limitation of claim 1 is not taught by the reference, claim 1 is not fully anticipated by Maaskamp. Thus, withdrawal of the rejection as it applies to claim 1 is respectfully requested.

Claims 2-3, 5-6, 8, 10-11, 14, and 16 which are dependent from claim 1 should also be allowable for at least the same reason.

***Claim Rejections - 35 USC § 103***

Claims 4, 18 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp in view of Murry et al (US 3990452; hereinafter "Murry"). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Claims 4, 18 and 27-28 have been cancelled. Thus, the rejection as it applies to claims 4, 18 and 27-28 should be withdrawn.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp in view of Rockley (US 2001/0021819). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Claim 9 has been cancelled. Thus, the rejection as it applies to claim 9 should be withdrawn.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp in view of Banko (US 6299591). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Claims 12-13 have been cancelled. Thus, the rejection as it applies to claims 12-13 should be withdrawn.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maaskamp in view of Freeman (US 4808154). Applicants respectfully request withdrawal of the rejection for at least the following reasons.

Claim 15 has been cancelled. Thus, the rejection as it applies to claim 15 should be withdrawn.

Regarding new claim 30, none of the above references discloses an apertured hollow cup-shaped member which enables aspirated material to pass from the cup-shaped member into the lumen.


New claims 31-38 which are dependent from new claim 30 should also be allowable for at least the same reason.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. L&C 41325.

Respectfully submitted,

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